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PORTLAND, OR 97204

**MAILED**

**OCT 07 2010**

**OFFICE OF PETITIONS**

In re Application of	:
William Ho Chang, et al.	:
Application No. 10/016,223	: DECISION ON PETITION
Filed: November 2, 2001	: UNDER 37 CFR 1.78(a)(6)
Attorney Docket No.: FXT302	:

This is a decision on the petition under 37 CFR 1.78(a)(6), filed October 5, 2010, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of priority to a prior-filed provisional application.

The petition is **DISMISSED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

This pending nonprovisional application was filed on November 1, 2001, within twelve months of the filing date of the prior-filed provisional application, Application No. 60/245,101, which was filed on November 1, 2000, and for which priority is claimed. A reference to the prior-filed provisional application has been included in an amendment to the first sentence of the specification following the title.

However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is

included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 119(e) after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 119(e) is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

Accordingly, before the petition under 37 CFR 1.78(a)(6) can be granted, a renewed petition under 37 CFR 1.78(a)(6) and either an Application Data Sheet or a substitute amendment (complying with 37 CFR 1.121 and 37 CFR 1.76(b)(5)) deleting the incorporation by reference statement, are required.

As authorized, the \$1,410 fee required by 37 CFR 1.78(a)(6)(ii) will be charged to petitioner's Deposit Account No. 11-1540.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

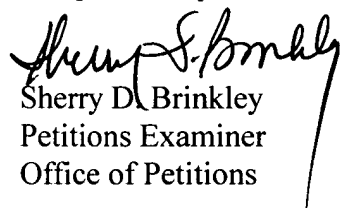
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Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204.

  
Sherry D. Brinkley  
Petitions Examiner  
Office of Petitions

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<sup>1</sup> [www.uspto.gov/ebs/efs\\_help.html](http://www.uspto.gov/ebs/efs_help.html) (for help using EFS-Web call the Patent Electronic Business Center at (866) 217-9197)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

William Ho CHANG, et al.

Date: October 5, 2010

Serial No. : 10/016,223

Group Art Unit 2445

Filed : November 1, 2001

Examiner Ajay M. BHATIA

For : WIRELESS DATA OUTPUT METHOD FOR RENDERING DIGITAL  
CONTENT ACCESSED FROM A MOBILE INFORMATION  
APPARATUS

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**OCT - 5 2010**  
**OFFICE OF PETITIONS**

**PETITION UNDER 37 C.F.R. § 1.78(a)(6)**

Applicant respectfully requests that the Patent Office accept the following unintentionally-delayed priority claim:

This application claims the benefit of U.S. Provisional Application No. 60/245,101, filed November 1, 2000, the entire disclosure of which is hereby incorporated by reference herein for all purposes.

The entire delay between the date the above priority claim was due pursuant to 37 C.F.R. § 1.78(a)(5)(ii) and the above date was unintentional. In particular, a previous version of the above priority claim was included in the original declaration as filed. Thus, the priority claim was not recognized. An amendment adding the above priority claim to the specification as the first sentence after the title is included with this petition.

The Commissioner of Patents is authorized to charge the fee of \$1,410.00 pursuant to 37 C.F.R. § 1.17(t) and any additional required fees associated with this

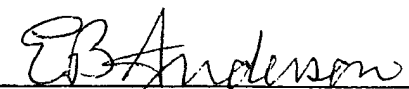
communication to Deposit Account 11-1540. If there are any questions regarding this matter, please telephone the undersigned.

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence is being sent by facsimile transmission to: Mail Stop PETITION, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on October 6, 2010.

  
Heidi Dutro

Respectfully submitted,  
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